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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/523,079	03/10/2000	Brian L. Gerhardt	13DV13466	4477
29399	7590	03/24/2006	EXAMINER	
JOHN S. BEULICK C/O ARMSTRONG TEASDALE LLP ONE METROPOLITAN SQUARE SUITE 2600 ST. LOUIS, MO 63102-2740			O'CONNOR, GERALD J	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/523,079	<b>Applicant(s)</b> Gerhardt	
	<b>Examiner</b> O'Connor	<b>Art Unit</b> 3627	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on February 28, 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 6-9, and 12 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6-9, and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on March 10, 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 30, 2006 has been entered.

### ***Preliminary Remarks***

2. This Office action responds to the request for reconsideration filed by applicant on January 30, 2006 in reply to the Office action on the merits mailed November 30, 2005.

### ***Response to Declaration Under 37 CFR 1.131***

3. The declaration filed on September 6, 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Brodersen et al. reference.

The evidence submitted is *insufficient to establish a reduction to practice* of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Brodersen et al. reference. While the disclosure document submitted *is sufficient to establish evidence of conception* of the invention, the disclosure document merely discloses the broad, general conceptual arrangements of the invention, as opposed to--for example and at a

minimum--the specific production computer code that one would necessarily possess once the invention had indeed been reduced to practice, such that the invention could be implemented/practiced/utilized.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1, 2, 6-9, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Brodersen et al. (US 2002/0065764), based on the December 17, 1999 filing date of parent application 09/466,262 (note the correct application number and filing date here of the parent application, as that information was incorrect on the face of the application as published, though it has since been corrected).

Regarding claims 1, 7, and 9, Brodersen et al. disclose a network-based parts distribution system and method comprising: a plurality of buyer computers for operation by a system participant desiring to obtain one or more parts; a plurality of seller computers for operation by a system participant desiring to sell one or more parts; at least one server computer, wherein said buyer computers, said seller computers and said server computer are interconnected as a computer network, said server computer being programmed to receive part related data from said seller computers and use said data to maintain a database of all available parts and to receive part requests from said buyer computers and select one or more parts from said database in response to said requests, wherein said parts in said database are sorted into a plurality of inventory categories, and wherein said parts in at least one of said inventory categories are further sorted into a plurality of sub-inventory categories based upon part condition; a signed master agreement between said system participants, including said system participants desiring to sell parts and said system participants wishing to obtain parts, said master agreement specifying terms of blanket purchase orders and said master agreement providing for auditing to check accuracy of said part-related data received from said seller computer; and, said server computer configured to relay a purchase order consistent with said specified terms of blanket purchase orders issued by one of said buyer computers to an appropriate one of said seller computers.

Regarding claims 2, 6, 8, and 12, the server computer of Brodersen et al. selects parts according to a buyer-specific picking order, and the computer network 18 is the Internet.

*Response to Arguments*

6. Applicant's arguments filed Jan. 30, 2006 have been fully considered but are not persuasive.

7. Regarding the argument that the declaration submitted under 37 CFR § 1.131 "shows that the subject matter claimed in the '079 patent application was conceived by [applicant] and reduced to practice prior to the date (December 17, 1999) [of the Brodersen et al. reference]," the declaration submitted under 37 CFR § 1.131 indeed shows that the subject matter was conceived by applicant prior to December 17, 1999, but it does not even contend that it was reduced to practice prior to December 17, 1999, merely prior to January, 2000, and, in any event, it does not *show* (i.e., prove) that it was reduced to practice prior to December 17, 1999 or any other date.

8. Regarding the argument that the "invention disclosure illustrates that work had been diligently proceeding to reduce the invention to practice and that this Application was filed promptly and diligently," the invention disclosure illustrates no such thing. The disclosure illustrates that the invention (including the concepts enumerated by applicant on pages 3 and 4 of applicant's remarks) was conceived, but nothing more. The disclosure does *not* illustrate that work had been diligently proceeding to reduce the invention to practice (though perhaps it was), *nor* does the disclosure illustrate that applicant's application was filed promptly and diligently (though perhaps it was, as well).

9. Regarding the argument that “Brodersen et al. do not disclose or suggest a signed master agreement between system participants, including system participants desiring to sell parts and said system participants wishing to obtain parts, the master agreement specifying terms of blanket purchase orders and the master agreement providing for auditing to check accuracy of the part-related data received from said seller computer and wherein the server computer is configured to relay a purchase order consistent with the specified terms of blanket purchase orders issued by one of the buyer computers to an appropriate one of the seller computers,” the functional language pertaining to the content/wording of the claimed printed matter/document has been deemed merely intended usage of the invention, hence, afforded little patentable weight. See MPEP §2114.

10. Regarding the argument that “Brodersen et al. do not describe nor suggest a method of distributing parts including obtaining agreements from system participants, including buyers and sellers, to join in a network-based, automated virtual warehouse parts distribution system, including agreements to terms of blanket purchase orders and auditing to check accuracy of data describing parts posted by sellers,” Brodersen et al. indeed describe and certainly suggest a method of distributing parts including obtaining agreements from system participants, including buyers and sellers, to join in a network-based, automated virtual warehouse parts distribution system, including agreements to terms of blanket purchase orders and auditing to check accuracy of data describing parts posted by sellers.

*Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to the disclosure.
12. All rejected claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.



13. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at **(571) 272-6771**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300**. Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

March 20, 2006

A handwritten signature in black ink, appearing to read "Gerald J. O'Connor", followed by the date "3/20/06" written in a similar cursive style.

Gerald J. O'Connor

Primary Examiner

Group Art Unit 3627